

Claim 1 is directed to an electrically controllable *safety device (emphasis added)*. Claim 10 is directed to a method of using an electrically controllable *safety device*. The safety device comprises a safety enhancer and a controller.

A key problem that the claimed apparatus solves is, as stated on pages 1 and 2 of the instant application, the avoidance of *premature deactivation* of safety devices. In particular, the scope of claims 1 and 10, is limited to safety devices, used in conjunction with vehicles powered by a motor activatable by an electrical ignition system, safety devices which the controller may only activate while the ignition system/motor of a vehicle is on and, *once activated*, may only be deactivated by turning the ignition system/motor off.

**US 5,921,355 to Mostrom:**

The Examiner rejects claims 1 and 10, under 35 USC § 102(e), as anticipated by US 5,921,355 to Mostrom. The Applicant respectfully disagrees.

First and foremost, the automobile anti-theft device disclosed in Mostrom is *not* a safety device both as illuminated in the present application and in the common usage of that phrase. A new and distinctive use of familiar electronics is patentable and is not anticipated by the disclosure of similar electronics for a very different purpose to solve a very different problem. On page 1 and elsewhere, the Applicant discusses safety devices including seat belts, emergency flashers, and other types of stimulators involving noise or light in order to alert a driver or occupant of a vehicle. Warnings to drivers and passengers of a vehicle clearly fall under the definition of a safety device. A device designed to (col.1, lines 23-25 of Mostrom) "frustrate would-be automobile thieves who do not have use of the automobile ignition key" does not promote safety, in any usual sense, to driver and passengers and *does not* fall under the definition of a safety device.

Furthermore, the device of Mostrom *does not* even use the same type of electronics, nor does it operate in a similar manner to the instant devices. Mostrom's anti-

theft device is actively effectuating its purpose when the ignition is *off*. It allows the car to run normally when the ignition is on. In many respects, this prior art device functions in an opposite sense electrically to the device claimed in pending claim 1. In Mostrom, the controller "activates" the anti-theft device by making the automobile impossible to steer while the ignition is off and *deactivates*, allowing unencumbered steering, *when the ignition is on*.

Significantly, on page 2 of the Office Communication, the Examiner appropriately characterized the Mostrom anti-theft device as being "controlled by the ignition system..." Namely, switching the ignition system "on" always means the Mostrom device is off; turning the ignition system "off" means that the Mostrom device is always on. He then attempts to demonstrate anticipation of the instant invention by stating that the controller element in our pending application is "controlled by the ignition system to activate or deactivate the instant safety device by turning the motor on or off." The Applicant asserts that the Examiner misunderstands the functioning of the instant claimed device. The device of claim 1 is *not* activated by turning the ignition switch on. This "ignition on" state is merely a prerequisite for the potential activation of the safety device. Col. 2, lines 33-50 provide the necessary support and disclosure for operation of the instant device. With the ignition on, the instant device is *activatable and is not deactivatable*. Not only is the instant device operated in an opposite electrical sense to the Mostrom electronics but, as described at col. 3, lines 1-7, and elsewhere, it is recommended that hardware (such as a momentary switch) must be selected to prevent reactivation of the safety device upon restarting the ignition switch after the motor has been off for some time period. In contrast, the prior art device operates so as to always become inactive when the motor is restarted. As for method claim 10, this claim requires powering the motor, followed by activating the device, which stays on until the ignition is turned off. The Mostrom device is "active" when the motor is off and remains active until the ignition is turned on, at which time it *deactivates*. Again, the Examiner states that the safety device presently claimed is turned on and off by the ignition key. This is not correct. The steps of method claim 10 are clearly not followed in the operation of the

Mostrom device and are not taught by this reference. Therefore, claims 1 and 10 cannot be anticipated by the Mostrom reference.

Independent device claim 2 and dependent claims 3-9 are directed to a stimulator which, once again, is only activatable when the ignition/motor is on as a prerequisite and can, then, only be deactivated by shutting the ignition/motor off.

**Other references to be combined with US 5,921,355 to Mostrom:**

The Examiner rejects claims 2-9 and 11 under 35 USC § 103(a) as rendered to be obvious by other references in view of and in combination with US 5,921,355 to Mostrom. The Applicant respectfully disagrees as use of these other references does not cure the problems stated previously regarding Mostrom. They merely add features common to the presently claimed device without addressing the problem of premature inactivation.

US 4,485,375 to Hershberger discloses a safety device, namely a "grip-responsive" driver alarm mounted on a steering wheel. His alarm uses light and sound to alert a driver (and any passengers) when the driver fails to continuously depress sensor(s) mounted on the wheel and may, therefore, be falling asleep. *However*, this reference fails to disclose a signal generator that may only be deactivated by shutting the ignition off, as the instant claims require. The Examiner relies on a combination with the Mostrom reference to render claim 2 obvious. Thus, the above discussion of the shortcomings of Mostrom in this regard also applies here. Also, it is implausible that one of ordinary skill would have any motivation to combine these two references. The references attempt to solve quite different problems (one to encourage safety when driving and the other to prevent unwanted theft). The alarm system of Hershberger also appears to be prone to premature deactivation (re-pressing the button(s) after letting go); the instant pending claims are to devices designed to prevent this. The fact that there are buttons or other actuators for drivers to depress is certainly not what is new or unobvious about the instant invention. It is that these new devices may not be prematurely deactivated.

Dependent claims 7-9 require particular electronic components to be featured in the claimed devices. The Examiner introduces US 5,389,913 to Boser et al to combine with Mostrom to find these claims to be obvious. Boser et al discloses a warning system related to an automobile horn. Boser utilizes changeover relays and diodes unlike the previously cited references. The Examiner must still, however, predominantly rely on the Mostrom reference to base a rejection on obviousness. Again, the Applicant maintains that the Boser reference is insufficient to resolve the significant differences between the Mostrom disclosure and the instant claims and specification. The Applicant recognizes that electronic components such as relays and diodes and their particular use to efficiently and effectively perform certain electrical functions in autos are not novel or non-obvious.

In addition, the Applicant includes a supplemental Information Disclosure Statement citing some references from China that were found during prosecution of a sister application in Taiwan. Note that these were discovered after issuance of the parent application of the Applicant. These have been translated for the benefit of the Examiner and tend to also illustrate that although the electronics for performing operations within different technical contexts involving motor vehicles are known, the combination provided in the claimed invention to attempt to solve the particular problem related to premature deactivation of motor vehicular safety devices is, as is asserted by the Applicant, patentable.

A final comment. Most generally, safety devices such as warning lamps for low oil or coolant are operational when the ignition switch is powered on. However, these sensor-driven safety devices can, and undoubtedly do, turn off while the engine and ignition are still running when sufficient fluid is added. It is a requirement in all of the pending claims that the safety devices of the present application be incapable of deactivation without turning the ignition/motor off.

### Conclusion

It is the position of the Applicant that the instant application is now in condition for allowance. Reconsideration of the application is, therefore, respectfully requested.

The Applicant hereby petition for a three-month extension of time. As the Applicant remains qualify as a small entity, a check for \$655.00 (\$475.00 for the extension fee and \$180 for the IDS submission) is enclosed herewith. If any additional fees are required for the timely consideration of this application, please advise as soon as possible. The undersigned is in the process of setting up a deposit account with the Office.

Respectfully submitted,

A handwritten signature in black ink, reading "Herbert A. Newborn". The signature is fluid and cursive, with the first letters of each name being capitalized and prominent.

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